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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/759,108	12/02/96	GIN	J 12.975

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EXAMINER REDDICK, M

ART UNIT 1505	PAPER NUMBER 3
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DATE MAILED: 07/11/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/759,108

Applicant(s)

QUIN ET AL

Examiner

Judy M. Reddick

Group Art Unit

1505



☒ Responsive to communication(s) filed on Feb 24, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) 17-32 and 34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 and 33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-34 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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15.

This application contains claims directed to the following patentably distinct species of the claimed invention: a) the instant acidic, water-swellaable, water-insoluble polymer which includes polyacrylamides, polyvinyl alcohol, ethylene maleic anhydride copolymer, polyvinyl ether, etc;

b) the instant basic material which includes polyamines, polyimines, polyamides, chitins chitosan, etc;.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-34 are generic. Applicant is required to elect an ultimate species of water-insoluble polymer a) and of basic material b) for further prosecution on the merits .

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-16 and 33, drawn to an absorbent composition which includes an acidic, H₂O- swellable, H₂O-insoluble polymer + a basic material and a disposable absorbent product, classified in Class 524, subclass 32.

II. Claims 17-32 and 34, drawn to an absorbent composition which includes a basic, water-swellable, water-insoluble polymer + an acidic material and a disposable absorbent product, classified in Class 524, subclass 32.

The inventions are distinct, each from the other because of the following reasons:

The absorbent composition of the Group I invention and the absorbent composition of the Group II invention are related a mutually exclusive species, each not requiring the particulars of the other for patentability. Note that the absorbent composition of the Group I invention is structurally different from the absorbent composition of the Group II invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. John Schenian on June 16, 1997 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16 and 33. Affirmation of this election must be made by applicant in responding to this Office action. Claims 17-32 and 34 have been withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

16.

Claims 1-16 and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "--water-insoluble polymer--" and "basic material" per claims 1 and 33 constitute indefinite subject matter as per the metes and bounds of the constituents qualifying such engender an indeterminacy in scope.

B) The recited "between about--to about--" per claims 1,2,10,11,13,16 and 33 constitutes indefinite subject matter as per the phrase "to about" is inconsistent with the quantifier "between". Use of "and" in lieu of "to about" is suggested.

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C) The recited "polyquaternary ammoniums" per claim 8 constitutes indefinite subject matter as per "polyquaternary" not being an art-recognized' term.

D) The recited "organic salts" and "salts" per claim 8 constitutes indefinite subject matter as per 1) the metes and bounds of said terms engender an indeterminacy in scope;

2) It is not apparent how "salts" differentiates over "organic salts."

17.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 and 33 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Nielsen et al. (U.S. 5,011,864).

Nielsen et al. disclose laminates derived from a water-absorbent composition which includes a mixture of a water-insoluble, water-swellaable polymer such as polyacrylic acid and chitin (≈ 5 to ≈ 35 wt.%). See, e.g., col. 2 lines 51-68 and cols. 2-6 of Nielsen et al. Nielsen et al. therefore anticipate the claimed invention.

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It is the base presumption that the claimed properties governing the water-absorbent composition may be met by the water-absorbent composition of Niesen et al. since it is essentially the same as and made in essentially the same way as applicant's composition. The onus to show otherwise is shifted to applicant as per Best et al. (195 USPQ 430).

18.

Claims 1-6 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Chmelir (U.S. 5,264,471).

Chmelir discloses water-absorbers defined as containing A) a water-sweallable polymer comfortably meeting component a) per claim 1 and B) which includes salts of inorganic and organic acids and comfortably meeting component b) per claim 1. Chmelir therefore anticipates the claimed invention. Inasmuch as no difference being seen between the instantly claimed invention and in the system of Chmelir, applicant has the onus to point out any different any why any difference found would have been unobvious.

19.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-16 and 33 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Gross (U.S. 5,612,411).

Gross discloses and exemplifies water-swellable, substantially water-insoluble materials and water-absorbent products therefrom which comprise, e.g., Currageenan (comfortably meets component 1a)) & Chitosan/CaCl₂ which comfortably meets component 1b)). See, e.g., the Abstract and cols. 2-12 of Gross. Gross therefore anticipates the claimed invention. Inasmuch as no difference being seen between the instantly claimed invention and the system of Gross, applicant has the onus of pointing out any difference and why any difference found would have been unobvious.

20.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-16 and 33 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Dairoku et al. (U.S. 5,610,208).

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Dairoku et al. disclose and exemplify water-absorbent compositions derived from a x-linked, water-absorbent resin containing a carboxyl group and comfortably meeting component 1a) and a salt of a polyamino acid and comfortably meeting component 1b). See, e.g., the Abstract, cols. 5-10 and the Examples of Dairoku et al. Inasmuch as no difference being seen between the instantly claimed invention and in the system of Dairoku et al., Applicant has the onus to point out any difference and why any difference found would have been unobvious.

21.

Note the attached FORM PTOL 892 for additional prior art cited as of being illustrative of the general state of the art.

Reddick/maj *JMR*
June 22, 1997

J. M. Reddick
JUDY M. REDDICK
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GROUP 150